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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Houghton et al.

Serial No.: 09/627,694

Examiner: A. Harris

Filed: 28 July 2000

Art Unit: 1642

For: Method and Compositions for Stimulation of an Immune Response to  
Differentiation Antigen Induced by Altered Differentiation Antigen

Petition Under 37 CFR § 1.144

Asst. Commissioner for Patents

Washington, D.C. 20231

Sir:

Applicants request review of the restriction requirement mailed March 1, 2001 for the above-captioned application. Applicants traversed and requested reconsideration of the restriction requirement, which was made final in the Official Action mailed May 16, 2001.

In the restriction requirement, the Examiner separated the claims of the instant invention into 8 groups, each of which she argues constitutes a separate invention. However, Applicants respectfully submit that the claims of groups IV, V, VI and VII should not be characterized as separate inventions, but should rather be the subject of a species election in accordance with 37 CFR § 1.146.<sup>1</sup> This is apparent, given the

<sup>1</sup> It is further noted that tyrosinase of added claim 40 should be considered another species.

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on July 18, 2001.

Marina T. Larson  
Marina T. Larson, PTO # 32,038

July 18, 2001  
Date of Signature

Examiners reference to claims 29-32 in the description of each of these groups of claims. These claims are generic claims, which link the several species.

The Examiner has argued (Office Action of May 16, 2001, Page 3 ) that the restriction requirement is proper because "each differentiation antigen is patentably distinct." This argument is inconsistent with the basic concept underlying a species-type restriction. As stated in § 809 of the MPEP, species-type restriction is appropriate "where, upon examination of an application containing claims to distinct inventions, linking claims are found." The generic claims are the linking claims. Thus, at a minimum, the Examiner should be instructed to restructure the restriction requirement as one in which claims 29 and 30 are treated as generic claims with gp75 considered as the elected species. Claims 34-37 and 40 would be recombined in accordance with MPEP § 809.02(b) if the generic claims were found to be allowable.

Furthermore, although the Examiner provided no substantive response to Applicants' arguments submitted in the response requesting reconsideration of the restriction requirement, Applicants further submit that claims 1-15 and 38-39 are properly considered with the elected claims. Claims 1 and 2 are generic claims relating to a method of stimulating an immune response. The claim recites the use of a therapeutic differentiation antigen that "is produced by expression in cells of a second species different from the first species." In the case of claim 2, the first species is specified as being human. Thus, claims 1 and 2 make use of the product produced in a cell lines of the type set forth in generic claims 29 and 30. While Applicants agree that the method claims could still be patentable even if art showing cell lines were located (i.e., when the cell line is used for a different purpose), Applicants submit that should the elected cell line claims be found to be novel and unobvious, these claims should be rejoined with the elected claims. See MPEP § 821.04. Applicants asked the Examiner to advise them now if such rejoinder would be considered so that an appropriate decision on a timely divisional could be made. No response to this request was received.

With respect to claims 38 and 39, these claims relates to an expression vector which is used in making the cell lines of the elected claims. Applicants submit that the subject matter of these claims sufficiently overlaps with that of the elected claims that there would be no substantial burden in examining them together. Specifically, it seems likely that any search for non-human cell lines, such as insect cell lines, that express a human differentiation antigen, will include a description of the compositions used in the creation of the cell line. Indeed, patents such as US Patent No. 6,046,025 are classified in both classes, and include claims and disclosure to both expression vectors and transformed insect cells. Thus, Applicants respectfully submit that these claims should be included with the elected claims, consistent with the statement in MPEP § 803 that

if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

For the foregoing reasons, Applicants request that the Examiner be directed to:

- (1) combine groups IV, V, VI, and VII, and added claim 40, into a single group with a species election requirement, Applicants having elected this combined group and made a species election of gp75 (claim 33);
- (2) withdraw the restriction requirement and consider claims 1-15 with the elected claims or advise Applicants if the claims will be combined should the elected claims be found allowable; and
- (3) withdraw the restriction requirement and consider claims 38 and 39 along with the elected claims.

The Commissioner is authorized to charge any fees associated with this petition to Deposit Account No. 15-0610.

Respectfully submitted,

A handwritten signature in cursive script, reading "Marina T. Larson", written over a horizontal line.

Marina T. Larson  
PTO Reg. No. 32,038  
Attorney for Applicants  
+1 970 468-6600 x152